

REMARKS

Applicant has carefully reviewed the Final Office Action mailed August 19, 2008, and thanks Examiner Hoekstra for the detailed review of the pending claims. In response to the Office Action, Applicant has amended claims 1, 8, and 14. By way of this amendment, no new matter has been added. Accordingly, claims 1-30 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections.

As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Applicant respectfully requests reconsideration of the present application in view of the above amendment, and the following remarks.

Claim Rejections – 35 U.S.C. § 103

Claims 1-8, 14-21, 27, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Privatera et al. (U.S. Patent No. 6,273,862, hereinafter "Privatera") in view of Moore (U.S. Patent No. 2,866,457, hereinafter "Moore"). Applicant respectfully traverses this rejection.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143.03. Accord. MPEP § 706.02(j).

Independent claims 1 and 14 positively recite in part, “the first check valve is selectively opened by a change of pressure within the outlet port.” The Examiner relies upon Moore to teach a check valve. However, the check valve of Moore is not taught as being selectively opened when a vacuum is applied to a port thereof. Further, Privatera does not include this teaching. Accordingly, the combination of Privatera and Moore cannot obviate independent claims 1 and 14.

Dependent claims 2-8, 15-21, 27 and 29 depend from claims 1 and 14 and are also not rendered obvious by Privatera and Moore simply by virtue of their dependency upon claims 1 and 14. Withdrawal of the 103 rejection is therefore respectfully requested.

Additionally, the dependent claims each contain additional features that are also not found in either reference. For example, claim 12 positively recites “wherein a vacuum created in the fluid connector by the vacuum assisted biopsy device is configured to draw a predetermined amount of fluid from the second fluid source through the output port and into the biopsy device when the second fluid source is connected thereto.” This limitation is not found in the combination of Privatera and Moore.

Claims 11, 13, 24, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Privatera in view of Moore, as applied to claims 1-8 and 14-21 above, and further in view of Turturro et al. (U.S. Patent No. 6,331,165, hereinafter “Turturro”). Applicant respectfully traverses this rejection.

Privatera and Moore do not render claims 1 and 14 obvious for at least the reasons stated above. Turturro does not cure these deficiencies. Specifically, Turturro does not teach or disclose “wherein the first check valve is selectively opened by a change of pressure within the outlet port,” as positively recited in independent claims 1 and 14. Therefore, for at least the

reasons stated above, claims 11, 13, 24 and 26 are allowable over any combination of Turturro, Privatera and Moore.

Claims 1-10, 12, 14-23, 25, and 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller et al. (U.S. Publication No. 2002/0082519, hereinafter “Miller”) in view of Moore. Applicant respectfully traverses this rejection.

Independent claims 1 and 14 positively recite, in part, “the first check valve is selectively opened by a change of pressure within the outlet port.” The Examiner relies upon Moore to teach a check valve. However, the check valve of Moore is not taught as being selectively opened when a vacuum is applied to a port thereof. Further, the Examiner incorrectly identifies the “pinch valve 402” of Miller as a check valve. Accordingly, the combination of Miller and Moore cannot teach the recitations of independent claims 1 and 14.

Claims 2-10 and 27-28 are dependent upon claim 1 and therefore include all of the limitations of claim 1 that distinguish claim 1 from Moore and Miller. Similarly, claims 15-23, 25, and 29-30 are dependent upon claim 14 and therefore include all of the limitations of claim 14 that distinguish claim 14 from Moore and Miller. For at least this reason, the Examiner is respectfully requested to withdraw the rejection.

Furthermore, the dependent claims each contain additional features that are also not found in either reference. For example, Moore fails to teach or suggest the resiliently compressible valve member claimed in claims 3 and 16, the predetermined cracking pressure of claims 8 and 21, and the relative level of the cracking pressure of claims 9, 10, 22 and 23. Miller adds no relevant disclosure which would teach or suggest any of the features. For at least this additional reason, the rejection of these claims over Moore and Miller should be withdrawn.

CONCLUSION

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed no fees are due with this response. However, if any fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 65937-0045 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

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Respectfully submitted,

Electronic signature: /Kenneth W. Jarrell/
Kenneth W. Jarrell
Registration No.: 52,484
Kristin L. Murphy
Registration No.: 41,212
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 10291
Attorneys for Applicant